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IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1977

NO. 77-667

GAYETTA BARKER,
EXECUTRIX OF THE ESTATE OF
FRANK S. BARKER,
and
WILLIS G. PEHL,

Petitioners,

v.

LUTRELLE F. PARKER, ACTING COMMISSIONER
OF PATENTS AND TRADEMARKS,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

PETITIONERS' REPLY BRIEF

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TABLE OF CONTENTS

	Page
DISPARITY OF STATEMENTS REGARDING DESCRIPTION REQUIREMENT.....	2
DECISIONS CITED IN RESPONDENT'S MEMORANDUM.....	5
NEW MATTER QUESTION.....	16
MISINTERPRETATION OF "NEW MATTER" STATUTE.....	19
CONCLUSION.....	23
CERTIFICATE OF SERVICE.....	25
CERTIFICATE OF SERVICE.....	25
CERTIFICATE OF SERVICE.....	26

TABLE OF AUTHORITIES

Cases:	Page
In re Bowen, 492 F.2d 859, 181 USPQ 48 (CCPA 1974).....	6, 18
In re Moore and Janoski, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).....	9, 10
In re Mott, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976).....	11, 12, 17, 18
In re Smith and Hubin, 481 F.2d 910, 178 USPQ 620 (CCPA 1973).....	7, 9
In re Winkhaus, Tusche, and Kampf, 527 F.2d 637, 188 USPQ 129 (CCPA 1975).....	13, 16, 17

Statutes:

35 U.S.C. 112.....	2, 14, 15, 16, 17, 19, 20, 23
35 U.S.C. 132.....	17, 19, 20, 24

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This statement is in reply to points raised by the Solicitor General in the Memorandum For The Respondent In Opposition.

DISPARITY OF STATMENTS REGARDING DESCRIPTION REQUIREMENT

The Petition For Writ Of Certiorari To The Court Of Customs And Patent Appeals has been presented to enable the United States Supreme Court to resolve the confusion resulting from the conflict as to an asserted "separate description requirement" in 35 U.S.C. 112

(a) between different decisions of the Court of Customs and Patent Appeals (Pet. 21-23),

(b) between the decision of the Court of Customs and Patent Appeals and prior decisions of the U.S. Supreme Court (Pet. 14-21), and

(c) between different decisions of Judge Miller (Pet. 24-25).

Respondent's Memorandum has added to the confusion, thus emphasizing the importance of the Supreme Court granting the petition to resolve the disparity between different statements as to the alleged "separate description" requirement of the statute.

Some prior decisions of the Court of Customs and Patent Appeals simply stated that there was a "separate

description" requirement, i.e. separate from the "enabling" requirement, which interpretation apparently has not been challenged prior to the appeal in the present case. When Judge Miller attempted to "interpret" the statute in the decision in the present case, he presented an illogical construction of the statute (Pet. 13). The Respondent's Memorandum does not support the interpretation of Judge Miller but, instead, proposes a different interpretation of the statute as to a "separate description" requirement, thus confirming petitioners' position that the present state of confusion with respect to the statute requires clarification by the Supreme Court.

Judge Miller interprets the description requirement of the statute as follows (Pet. C-16 and C-17):

> "...35 USC 112, first paragraph, contains separate requirements for--
>
> "a written description [1] of the invention, and [2] of the manner and process of making and using it, in such full,

> clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same . . . ." (Emphasis supplied)

Rather than supporting this interpretation of Judge Miller, the Respondent's Memorandum at page 4 states a different interpretation as follows:

> "...Section 112 imposes two requirements: (1) that there be a 'description' of the invention and of the manner and process of making and using it, and (2) that such description be sufficiently clear that one skilled in the art may make and use the invention."

In this statement, the Respondent has repeated the word "description" in the two "requirements" specified indicating that there are two adjectival clauses modifying "description." It is respectfully submitted that while this interpretation is not as illogical as that of Judge Miller, it is still not logical to chop the statute into two independent and unrelated requirements.

Viewing the matter in another way, Judge Miller stated petitioners' position as follows (Pet. C-8 and C-9):

> "They would interpret the phrase in section 112 'in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same' as modifying 'description';..."

Is that not precisely the position of Respondent's second requirement on page 4:

> "...and (2) that such description be sufficiently clear that one skilled in the art may make and use the invention." ?

Judge Miller states (Pet C-9, line 8):

> "We do not agree."

Thus Respondent is asserting an interpretation of the statute with which Judge Miller, who wrote the majority opinion of the Court of Customs and Patent Appeals decision, does not agree.

Only the Supreme Court can resolve the four-way split of statutory interpretation between the Respondent, Judge Miller, Judge Rich and Judge Markey.

DECISIONS CITED IN RESPONDENT'S MEMORANDUM

The prior decisions cited at the bottom of page 4 and in footnote 4 of

the Repsondent's Memorandum are really of no help in resolving the four aforesaid different interpretations of the statute because they either simply state categorically that there is a "separate description" requirement in the statute without attempting to really construe or interpret the statute, or other statements are made regarding the statute which are inconsistent with one or more of the four positions referred to above and, consequently, further confound the confusion.

Prefacing the citation of cases, the Respondent's Memorandum states:

> "...the Court of Customs and Patent Appeals has continued to recognize that 'there is a description of the invention requirement in 35 USC 112, first paragraph, separate and distinct from the enablement requirement." (Emphasis supplied) (Res. Memo. 4)

How do the decisions cited support this pronouncement?

In *In re Bowen*, 492 F. 2d 859, 181 USPQ 48 (CCPA 1974), the Court stated:

"The first paragraph of § 112

requires only that the specification enable any person skilled in the art to which the invention pertains to make and use the invention....The only other possible basis in the first paragraph of § 112 is the description requirement, relied upon by the solicitor, and dealt with next.

"The Description Requirement

"The solicitor's reliance on what this court has referred to as the 'description requirement' of the first paragraph of § 112 is misplaced. The so-called 'description requirement,' which exists in the first paragraph independent of the enablement (how to make and how to use) portions, serves essentially two functions. In the simple case, where no prior application is relied upon, the description requirement is that the invention claimed be described in the specification as filed." (Italics theirs) (182 USPQ 48, 52)

If the specification describes the invention in a manner which enables any person skilled in the art to which the invention pertains to make and use the invention, what more is required?

In *In re Smith and Hubin*, 481 F.2d 910, 178 USPQ 620 (CCPA 1973), the Court

stated:

> "The board's opinion does not precisely set forth which of the several specific disclosure requirements of the first paragraph of § 112 is deemed not to be satisfied. We think that in its essence, the rejection is founded on the conclusion that the specification does not describe the invention as broadly as it is claimed. There is little language which is evocative of a position that the specification does not enable one skilled in the art to *use* the invention as broadly as it is claimed. However, we will deal with both the principal rejection based on the failure to satisfy the description requirement as well as a possible rejection based on the failure to satisfy the how-to-use requirement. We think it is clear that there has been no challenge to the specification disclosure with respect to either the manner of making the claimed invention or the best mode contemplated, and the solicitor does not contend otherwise.
>
> "The 'Description' Requirement
>
> "This court has repeatedly recognized a separate description requirement in the first paragraph of § 112. See In re Smith, 59 CCPA _____, 458 F.2d 1389, 1394, 173 USPQ 679, 683 (1972), and cases there cited." (Italics theirs) (178 USPQ 620, 623)

The Court, however, does not provide any interpretation as to where the language of the statute requires a "separate description." The Court goes on to say, however:

> "Compliance with the first paragraph of § 112 is adjudged from the perspective of the person skilled in the relevant art. This court has held that claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement,..." (178 USPQ 620, 624)

This statement suggests that, contrary to the ruling of Judge Miller, if, from reading the description of the specification, a person skilled in the particular art can understand how to make and use the invention, the "description" requirement is satisfied.

In *In re Moore and Janoski*, 58 CCPA 1042, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971), the Court stated:

> "This first paragraph analysis in itself contains several inquiries. Considering the language of the

statute, it should be evident that these inquiries include determining whether the subject matter defined in the claims is described in the specification, whether the specification disclosure as a whole is such as to enable one skilled in the art to make and use the claimed invention, and whether the best mode contemplated by the inventor of carrying out that invention is set forth.

"Two of the first paragraph requirements indicated above, i.e., the 'description of the invention' and the 'best mode' requirements, are relatively simple to comply with..." (169 USPQ 236, 238 and 239)

Here again, it appears that, contrary to the ruling of Judge Miller, the 'description of the invention' requirement is satisfied if one skilled in the art can obtain sufficient information from the specification as to enable him to make and use the invention. What more is required?

This conclusion is confirmed by the further statement of the Court in the *Moore et al.* case that:

"What is of maximum concern in any analysis of whether a particular claim is supported by the disclosure in an application is whether that disclosure contains sufficient teaching regarding the subject matter of the claims as to enable one skilled in the pertinent art to make *and* to use the claimed invention. These two requirements, 'how to make' and 'how to use' have sometimes been referred to in combination as the 'enablement' requirement, but, in one form or another, have been the subject of extended discussion in this court of recent years. The relevant inquiry may be summed up as being whether the scope of enablement provided to one of ordinary skill in the art by the disclosure is such as to be commensurate with the scope of protection sought by the claims." (Italics theirs) (169 USPQ 236, 239)

Does this statement indicate that the statute has a "description" requirement <u>separate</u> from an "enablement" requirement?

In re Mott, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), stated:

"The § 112 rejections are based on the description requirement of § 112, first paragraph, as enablement and disclosure of best mode have not been questioned." (190 USPQ 539)

Here is simply a <u>categorical assumption</u>

that § 112 has a requirement for a "description" separate from the "enablement" provision, without any attempt to analyze or interpret the statute.

In commenting upon the "separate description" assumption, the Court stated:

> *"The Section 112 - Section 132 Rejection*
>
> "The issue under this heading is whether appellant's specification, construed in light of the knowledge of those skilled in this art, contains a written description of the subject matter of claims 42, 44, and 46." (Italics theirs) (190 USPQ 536, 541)

Is such issue to be considered entirely without regard as to whether the description is

> "...sufficiently clear that one skilled in the art may make and use the invention."

in the words of Respondent's Memorandum under item (2) at page 4, lines 7 to 9? If so, of what value is such a description?

Without quoting the language of the statute, the Court in the *Mott* decision

went on to state:

> "Appellant's application must contain sufficient disclosure, expressly or inherently, to make it clear to persons skilled in the art that appellant possessed the subject matter claimed." (190 USPQ 536, 541)
>
> "...it does not matter under §112, first paragraph, *how* the specification describes the specific subject matter he later claims. The specification must merely do so in *some* way in order to comply with the description requirement. Accordingly, appellant need not have disclosed specific structures in order to have described the invention of claim 44 if his disclosure is otherwise adequate to show that he did in fact possess that subject matter." (Italics theirs) (190 USPQ 536, 542)

Would the "description requirement", Respondent's first requirement, be complied with if the description were not, in the language of Respondent's second and asserted separate requirement, sufficiently clear that one skilled in the art may make and use the invention?

In *In re Winkhaus, Tusche, and Kampf*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), the Court stated:

> "Although it may be *apparent*, as appellants argue, that the vapors of the reaction mixture at the end of a given heating zone *could* be utilized for heating the mixture flowing through this zone, that does not mean that such a step is *described* as part of their invention. That a person skilled in the art might realize from reading the disclosure that such a step is *possible* is not a sufficient indication to that person that that step is part of appellants' invention. Such an indication is the least that is required for a description of the invention under the first paragraph of §112." (Italics theirs) (188 USPQ 129, 131)

Should the description be considered with respect to a person skilled in the art <u>but entirely apart from the understanding which such a person might gain with respect to being able to make and use the invention</u>? How can a "<u>separate</u> description" requirement, as contended by Judge Miller, be satisfied <u>without</u> that description being sufficiently

> "...full, clear, concise, and exact...as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use

> the same,"

as recited in 35 U.S.C. 112?

It is evident that the foregoing decisions cited in Respondent's Memorandum do not attempt to analyze or interpret the specific language of 35 U.S.C. 112.

The Respondent's Memorandum concludes at the top of page 5 that the decision of the Court of Customs and Patent Appeals in this case does not warrant further review because that decision

> "...merely 'reaffirm[s the court's] recognition that 35 USC 112, first paragraph, contains separate requirements'..."

The difficulty is that the "separate requirements" of the statute proposed by Judge Miller (Pet C-16 and C-17) <u>are different</u> from the "separate requirements" set forth in Respondent's Memorandum at page 4, lines 4 to 9 as well as being different from the views of Judge Rich and Judge Markey. <u>Which</u> of these four inconsistent interpretations should be applied in future Court decisions? The previous decisions of the CCPA cited in

Respondent's Memorandum do not resolve this issue as shown by the foregoing quotations from them.

NEW MATTER QUESTION

The Respondent's Memorandum at page 5 points out that "in any case," presumably whether or not the Supreme Court should review the decision of the Court of Customs and Patent Appeals with respect to 35 U.S.C. 112, the judgment of the CCPA is supported independently by the adjudication of new matter. Actually, any issue as to the type of "new matter" asserted to exist in the present case is inextricably interwoven with the interpretation of 35 U.S.C. 112 and the actual determination of the case is controlled by the interpreation of that statute. This situation is indicated by the statement in the case of *In re Winkhaus et al.*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), cited at the bottom of page 5 of Respondent's Memorandum.

That the consideration of the

interpretation of § 112 is linked to such assertion of new matter under 35 U.S.C. 132 is indicated by repeating the last portion of the quotation above from the *Winkhaus et al.* decision and continuing it as follows:

> "Such an indication is the least that is required for a description of the invention under the first paragraph of §112. See In re Smythe, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973). Claims added by amendment and drawn to an invention not so described in the specification are drawn to 'new matter' and prohibited by §132." (188 UPSQ 129, 131)

The interrelated character of these two considerations is further indicated by the decision of *In re Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976) also cited by the Respondent in footnote 4, which stated:

> "The §112 rejections are based on the description requirement of §112, first paragraph, as enablement and disclosure of best mode have not been questioned. The §132 rejections are on the same basis." (Emphasis supplied) (190 USPQ 536, 539)

In the opinion, the heading is given

"The Section 112 - Section 132 Rejection" (Italics theirs) (190 USPQ 536, 541)

Under that heading the Court stated:

> "That Keithahn considered *his* valve to posses the function of response to well (and earth) surface conditions does not require the conclusion that a person skilled in the art would read appellant's mere description of automatic control means as encompassing the same function, i.e., response to conditions at the well surface, to show possession of the invention by appellant. The rejection of claim 46 under §112 and §132 is affirmed." (Italics theirs) (190 USPQ 536, 543)

The actual question which was considered by the Court was:

> "...what meaning persons skilled in the art would attribute to his disclosure for purposes of §112 and §132..." (190 USPQ 536, 541)

The case of *In re Bowen*, 492 F.2d 859, 181 UPSQ 48 (CCPA 1974) stated:

> "The solicitor's reliance on what this court has referred to as the 'descripton requirement' of the first paragraph of § 112 is misplaced....where no prior application is relied upon, the description requirement is that the invention claimed be described in the specification as filed. [citing cases] As such, a rejection on the description requirement is tantamount to a new matter rejection under 35 U.S.C. 132." (181 USPQ 48, 52)

The confusion and interrelationship between 35 U.S.C. 112 and 35 U.S.C. 132 in cases such as the present is therefore clearly such that one cannot be considered independently of the other.

MISINTERPRETATION OF "NEW MATTER" STATUTE

The Respondent's Memorandum on page 5 accurately quotes 35 U.S.C. 132 in part as follows:

> "'[n]o amendment shall introduce new matter into the disclosure of the invention.'" (Emphasis supplied)

Neither the Respondent's Memorandum nor any of the three opinions of the CCPA *Barker et al.* decision (Pet. App. C-1 to C-27) asserts that petitioners introduced new matter into the "disclosure" of the invention as specified in the portion of the statute quoted above and in the Respondent's Memorandum. There is, however, an error in Respondent's Memorandum on page 5 in quoting from the

decision.

There are two references to new matter in the decision, both of which are quoted in Respondent's Memorandum on page 5. The first quotation at lines 9 to 12 is by Judge Miller. The second quotation regarding new matter at Pet. App. C-21 quoted on page 5, lines 21 to 24, was by Judge Rich in the concurring opinion.

Note that each of these quotations refers to the statement in the claim and not in the disclosure as constituting the new matter. The decision does not discuss the "new matter" assertion at all.

The confusion between 35 U.S.C. 132 and 35 U.S.C. 112 is further emphasized by the statement of Judge Rich at Pet. App. C-21 immediately following the second quotation, as to new matter on page 5 of Respondent's Memorandum, the full quotation being:

> "...new matter, in violation of 35 USC 132, was inserted by amendment and the claim contains that new matter. It therefore lacks support and must be rejected. The decision

> is in accord with many of our prior interpretations of 35 USC 112..."

The Respondent's Memorandum appears to be somewhat misleading in the statement at the middle of page 5, namely,

> "Although 'some criticality' exists in the length of the backing board (Pet. App. A-3), petitioners did not claim a new method of constructing panels of a six-shingle width in their original specifications; that limitation appeared for the first time in Claim 18 (Pet. App. C-19)." (Emphasis supplied)

in three respects.

The first respect is the reference to "some criticality" with respect to the length of the backing board. Such "criticality" is the product of the imagination of the Patent and Trademark Office Board of Appeals. Actually, no such criticality exists because it was stated in petitioners' specification that suitable connecting means may be provided to connect the adjacent ends of adjacent backing boards without having a bearing member beneath the joint in each instance.

The second respect involves the statement that petitioners did not claim

a new method of constructing panels of a six-shingle width in their original specifications. Claim 1 did not specify any particular number of shingles, but claim 5, dependent on claim 1, specified that the shingles be arranged in a repetitive pattern, and claim 6, dependent on claim 5, specified that each shingle in the panel is one of three widths. Thus a repetitive pattern of three different shingle widths would be six shingles. Claim 18 does not specify "panels of a six-shingle width," however, but states "at least six shingles," as quoted on page 5, line 9, of Respondent's Memorandum.

The third respect is that claim 18 does not contain a "limitation" to "panels of a six-shingle width", but the claim specifies:

> "...at least three different predetermined widths..."

and

> "...at least six shingles." (Pet. App. A-1)

The Respondent's Memorandum concludes at the bottom of page 5:

> "Petioner does not challenge and the record (Pet. App. A-3 to A-4) amply supports this factual determination, which independently supports the judgment below."

What is the "factual determination" to which this statement refers?

CONCLUSION

It is respectfully submitted that the Respondent's Memorandum, instead of clarifying the situation, has emphasized the incorrectness of Judge Miller's interpretation of 35 U.S.C. 112, or at least the susceptibility of the statute to different interpretations by legal minds, so that this Honorable Court should grant the Petition for Certiorari and establish authoritatively the meaning of this statute to guide future decisions of lower courts.

Also, this Honorable Court should grant the petition to clarify whether simply broad language in a claim

constitutes "new matter" in the "disclosure," which is prohibited by 35 U.S.C. 132.

Respectfully submitted,

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RWB/bcm

February 1978.

CERTIFICATE OF SERVICE

It is hereby certified that on this ____ day of February, 1978, five copies of the printed PETITIONERS' REPLY BRIEF were served by first-class prepaid mail upon Joseph F. Nakamura, Solicitor, U.S. Patent and Trademark Office, Washington, D. C. 20231.

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Robert W. Beach

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It is hereby certified that on this ____ day of February, 1978, six copies of the printed PETITIONERS' REPLY BRIEF were served by first-class prepaid mail upon the United States Court of Customs and Patent Appeals, 717 Madison Place Northwest, Washington, D. C. 20439.

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Robert W. Beach

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Robert W. Beach